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ARLINGTON, VA 22203

In re Application of
HEDLUND ET AL.
Application No.: 09/840,029
Filed: April 24, 2001

DECISION ON PETITION

This is a decision on petitioner's request filed August 16, 2004, requesting withdrawal of the restriction requirement in the office action mailed on March 17, 2004. The restriction requirement was made final in the office action mailed on July 22, 2004.

The petition is granted.

MPEP 806.03 states in part:

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

MPEP 806.05(c) states in part:

III. SOME COMBINATION CLAIMS RECITE SPECIFIC FEATURES OF THE SUB-COMBINATION BUT OTHER COMBINATION CLAIMS GIVE EVIDENCE THAT THE SUBCOMBINATION IS NOT ESSENTIAL TO THE COMBINATION.

AB_{sp} / AB_{br} (Evidence Claim) / B_{sp} Restriction Proper

Art Unit: 3742

Claim AB_{br} is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If claim AB_{br} is subsequently found to be unallowable, the question of rejoinder of the inventions restricted must be considered and the letter to the applicant should so state. Therefore, where the combination evidence claim AB_{br} does not set forth the details of the subcombination B_{sp} and the subcombination B_{sp} has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction.

Petitioner has requested that the restriction requirement between Groups I, II, III and claims 31-36 as set forth in the office actions of March 17, 2004 and July 22, 2004 be withdrawn. Claims 18-30 which were directed to Groups IV, V, and VI have been canceled.

A review of the claims reveals that claims of Groups II and III, and claims 31-36 are directed to a single embodiment of the combination of the magnetic resonance (MR) microscopy method and merely vary in breath and /or scope of definition. As such restriction between these claims is improper. MPEP 806.03. It is further noted that examiner failed to provide a reason for restriction between Groups II and III in the restriction requirement mailed March 17, 2004.

Group I is directed to a subcombination of Groups II, III and claims 31-36. MPEP 806.05(c) III indicates that restriction is proper when there is an evidence claim that indicates that the combination does not rely upon the specific details of the subcombination for its patentability and the subcombination has separate utility. A review of subcombination claim 1 and combination claim 6 indicate that combination claim 6 does not require the details of subcombination claim 1. In particular, claim 6 does not require generation of a trigger signal found in claim 1 and claim 1 has separate utility as being used in other medical testing procedures, for example, referencing an optic perfusion study to the heart cycle or performing heart-synchronized echocardiographic study.

Since the restriction requirement was at least partially improper due to the division of claims 6-17 and 31-36, the requirement is withdrawn. Any restriction requirement between the subcombination and combination must be set forth again and petitioner given the opportunity to elect an invention based upon a proper restriction.

While the restriction requirement is being withdrawn, it is noted that petitioner's argument with regard to no burden of search and claims having at least one common limitation were not found persuasive. The fact that the examiner searched the class and subclass where the combination is classified is not an indicator as to whether additional class/subclasses would need to be searched for the combination. As discussed above, the test for restriction between combination and subcombination claims is not whether there is common subject matter but whether the details of the subcombination are required for patentability in the combination and that the subcombination has separate utility.

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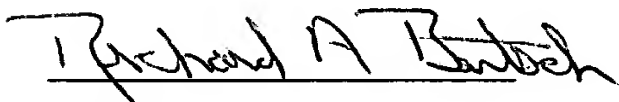
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Petitioner's current claims include evidence claim 6. In addition, the common subject matter argued by petitioner was not indicated as allowable by the examiner in claim 1.

It is also noted that a petition for acceptance of color drawings was filed and has not yet been decided. This petition will be brought to the attention of the deciding official, the supervisory patent examiner.

Summary: petition granted.

The application will be forwarded back to the examiner for action not inconsistent with this decision.

A handwritten signature in dark ink, reading "Richard A. Bertsch". The signature is written in a cursive, flowing style with a horizontal line underneath the name.

Richard A. Bertsch, Director
Technology Center 3700